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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,149	03/19/1999	KEVIN M. PINTAR	22074661-255	6715

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/273,149	PINTAR ET AL.
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 June 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15 and 18-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15, and 18-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the remarks and 37 CFR 1.131 declaration filed on

6/30/2006.

This action is made Final.

2.   In the amendment, claims 21-26 have been added. Claims 1-15, and 18-26 are pending in

the case. Claims 1, 8, 15 and 23 are independent claims.

Drawings

3.   This application has been filed with informal drawings which are acceptable for

examination purposes only. Formal drawings will be required when the application is allowed.

Response To Declaration under 37 CFR § 1.131

6.   The declaration filed on 6/30/2006 under 37 CFR 1.131 has been considered but is

ineffective to overcome the effective filing date of the Allen (Pat.# 6,502,236, 12/31/2002, filed

on 3/16/1999) reference.

The evidence submitted is insufficient to establish the conception date of the invention in

this country or a NAFTA or WTO member country. Applicant points to "Exhibit A" as proof of

the date of conception. However, the Exhibit does not contain any signatures from the inventors

listed therein.

Moreover, each exhibit relied upon should be specifically referred to in the declaration in terms of what it is relied upon to show. The declaration must clearly explain which <u>facts or data</u> applicant is relying on to show that the invention was completed prior to a certain date. There is no explanation as to how "Exhibit A" relates to the claimed invention. The declaration does not show which claims are supported by Exhibit A, and which limitations are supported by a certain portion of the Exhibit.

Further, the applicant must clearly explain the exhibits, drawings, or any evidence which forms part of the declaration, to point out exactly what facts are established and relied upon to support the declaration, in order to meet the statutory requirements of 37 CFR 1.131. There is no explanation detailing in what manner the drawings of Exhibit A support the claimed invention.

The applicant has included a general and vague statement as to when the invention was conceived, the proof of conception, and reduction to practice. <u>A mere statement declaring that the invention was conceived or reduced to practice by a specific date predating the applied prior art reference is insufficient to satisfy 37 CFR 1.131.</u>

Furthermore, the draft amendment in exhibit A does not appear to be an original draft amendment submitted in March 1999, since it is showing status markings enacted in 2003.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. This proof is demonstrated with <u>satisfactory evidence of facts</u> supporting priority of invention, said proof usually in the form of exhibits. Examples of support include attached sketches, blueprints, photographs, reproduction of notebook entries, accompanying models, supporting statements by witnesses, interference testimony, and/or prior submission to the USPTO of Disclosure Documents.

In view of the examples of support as explained above, it is the examiner's opinion that

the presented combination of evidence within Exhibit A (an unsigned copy of claims submitted

to Baker Botts, LLC., not clearly explaining which facts are relied upon to back up the

conception date of the invention), is insufficient proof that Applicant's invention was conceived

before the publication date of the Allen reference. Accordingly, said affidavit is ineffective to

overcome the effective filing date of the Allen reference at the present time (see MPEP 8th

Edition, section 715.07).

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

5.   The rejections of claims 8-15, and 18-20 rejected under 35 U.S.C. 112, first paragraph,

have been withdrawn as necessitated by the amendment.

6.   The rejections of claims 8-14 under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement, have been withdrawn as necessitated by the amendment.

7.   Claims 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention. The claim recites: "the application

program calls the first data conversion routine when executing the first data conversion

routine." (lines 2-3). This seems vague, because it suggests that the first data conversion routine

was already being executed. The examiner could not find how the newly amended limitation is

described in the specification as to allow one of ordinary skill in the art to carry out the calling of

the data conversion routing when it was already executing.

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

9.   Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The claim recites: "the application program calls the first data conversion

routine when executing the first data conversion routine." (lines 2-3). This seems vague, because

it suggests that the first data conversion routine was already being executed. It is not clear how

the conversion routine is called, when it is already executing.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

11.   Claims 1-6, 8-12, 15, and 18-19 remain rejected under 35 U.S.C. 102(e) as being

anticipated by Allen et al, hereinafter Allen (Pat.# 6,502,236, 12/31/2002, filed on 3/16/1999).

        Regarding independent claim 1, Allen discloses the automatic generation by an

application, such as a forwarding device, of a program based on a number of received input, and

output format descriptors—*first, and second attributes*--, such as Ethernet, and IP formats—*input

and output data types* (col. 2, lines 28-67, col. 10, lines 33-47).

        Moreover, Allen teaches the automatic generation in real-time—*dynamically creating at

runtime*--of a conversion program—*first optimized conversion routine*-- such as an assembler

program, based on the input, and output format descriptors. The conversion program or translator

has methods—*computer instructions*—for interpreting format descriptors, and convert data units

from a first to a second format through or during the interpretation or executing of these methods

(col. 2, lines 28-67, and col.4, lines 51-65).

        Furthermore, Allen teaches the compilation of a generated program translation objects by

a fast compiler—*validating specific field conversion options of the conversion routine*, and the

execution of the program, by a modification engine —*application*-- to convert a received data

unit to an output data unit described by the input, and output format descriptors, such as

Ethernet, and IP formats, which are not dependent on or different from each other (col. 2, lines

28-38, 57-67, col.3, lines 54-67, col.4, lines 35-65, and col. 6, lines 1-67, fig.2).

        Regarding claim 2, which depends on claim 1, Allen teaches the execution—*calling*-- of

the program-*first optimized routine*--, by an implementation of the forwarding device—

application-- to convert a received data unit to an output data unit described by the input, and output format descriptors, such as Ethernet, and IP formats, which are not dependent on or different from each other (col. 2, lines 20-38, 50-67, col.3, lines 49-67, and fig.2).

Regarding claim 3, which depends on claim 1, Allen teaches the execution of the program-*first optimized routine--*, by a modification engine—*application--*, for converting between the two formats, where the program executes from within the modification engine, which is part of the forwarding device system (fig.2) or is stored inline with the forwarding device application (col. 2, lines 20-38, 57-67, col.3, lines 40-42, 50-67).

Regarding claim 4, which depends on claim 1, Allen discloses the automatic generation in real time by an application—*step b performed dynamically while the application executes* translation steps--, such as a forwarding device, of a program based on a number of received input, and output format descriptors—*first, and second attributes--*, such as Ethernet, and IP formats (col. 2, lines 20-67, col. 3, lines 50-67, and col. 10, lines 33-47).

Regarding claim 5, which depends on claim 1, Allen discloses the automatic generation by an application, such as a forwarding device, of a program based on a number of received input, and output format descriptors, such as word objects 62, and 68—*third, and fourth attributes--*, such as Ethernet, and IP formats—*input and output data types* (col. 2, lines 28-67, col. 10, lines 33-47, and col. 6, lines38-64,).

Moreover, Allen teaches the automatic generation in real-time—*dynamically creating at runtime*--of a new translator for each of the word objects—*second optimized conversion routine*-- such as an assembler program, based on the input, and output format descriptors (col. 2, lines 28-67, and col.4, lines 51-65, and col. 6, lines38-64).

Furthermore, Allen teaches the execution of the program, by a modification engine — *application*-- to convert a received data unit to an output data unit described by the input, and output format descriptors, such as Ethernet, and IP formats, which are not dependent on or different from each other (col. 2, lines 28-38, 57-67, col.3, lines 54-67, and col. 6, lines38-64 fig.2).

Regarding claim 6, which depends on claim 1, Allen discloses the automatic generation in real-time of a new translator for converting data types, such as alphabetic characters (col. 2, lines 28-67, and col.4, lines 16-65).

Claim 8 is directed towards a method for implementing the steps found in claim 5, and therefore is similarly rejected.

Regarding claim 9, which depends on claim 8, Allen teaches Allen's inclusion of conversion programs partly or in whole (col.10, lines 26-32). In other words, the size of the computer code is chosen. The size chosen is either a small portion of the program or entire conversion functions-- *determining the size of the data conversion routine for each of the plurality of sets of input attributes and output attributes.*

Regarding claim 10, which depends on claim 8, Allen teaches the storage of the translators in the forwarding device system (fig.2) or is stored inline with the forwarding device application (col. 2, lines 20-38, 57-67, col.6, lines 29-50)-- *determining whether the data conversion routine for each of the plurality of sets of input attributes and output attributes should be stored inline with said application program.*

Regarding claim 11, which depends on claim 8, Allen discloses the automatic generation in real time by an application—*step c performed dynamically while the application executes translation steps*--, such as a forwarding device, of a program based on a number of received input, and output format descriptors—*first, and second attributes*--, such as Ethernet, and IP formats (col. 2, lines 20-67, col. 3, lines 50-67, col. 6, lines 29-63, and col. 10, lines 33-47).

Regarding claim 12, which depends on claim 8, Allen discloses the automatic generation in real-time of a new translator for converting data types, such as alphabetic characters (col. 2, lines 28-67, and col.4, lines 16-65).

Claims 15, and 18-19 are directed towards a computer system for implementing the steps found in claims 8, and 11-13 respectively, and are similarly rejected.

Claims 21-22 are directed towards a computer system for implementing the steps found in claims 9-10 respectively, and therefore are similarly rejected.

Claims 23-25 are directed towards a logic encoded in a computer-readable medium for

implementing the steps found in claims 5, 1, and 10 respectively, and therefore are similarly

rejected.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

13.   Claims 7, 14 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Allen, in view of DaSilva (Pat. # 6,493,868, 12/10/2002, provisional application filed on

11/2/1998).

Regarding claim 7, which depends on claim 1, Allen discloses the automatic generation

in real-time of a new translator for converting data types, such as alphabetic characters (col. 2,

lines 28-67, and col.4, lines 16-65). Allen fails to explicitly teach *generating program debugging*

instrumentation. DaSilva discloses: allowing developers to visually probe, trace, and monitor

DSP application's real time performance using breakpoints, probe points (col.2, lines 35-col.3,

line 9). It would have been obvious to one of ordinary skill in the art at the time of the invention

to have debugged the routine, because Mcallum teaches above, the visual probing, tracing and monitoring DSP applications with minimal impact to the real time performance of the applications.

Claims 14, and 20 are directed towards a computer system for implementing the steps found in claim 7, and therefore are similarly rejected.

Claim 26 is directed towards a logic encoded in a computer-readable medium for implementing the steps found in claim 7, and therefore is similarly rejected.

14.   Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Allen.

Regarding claim 13, which depends on claim 8, Allen discloses the automatic generation in real-time of a new translator for converting data types, such as alphabetic characters (col. 2, lines 28-67, and col.4, lines 16-65). Allen fails to explicitly teach *said input and output attributes are date type*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the date type, because Allen teaches a system that is fast enough to handle new operational requirements as they are received (col.2, lines 15-24, 61-67), thus saving time.

Response to Arguments

15.   Applicant's arguments filed on 6/30/2006 have been fully considered but they are not

persuasive. Regarding claims 1, 8, 15, and, 23 the Applicants indicates that Allen is not a valid

reference in light of the 37 CFR 1.131 declaration (page10). As indicated above, the declaration

is insufficient to overcome Allen at this time.

Conclusion

16.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

I.   Any inquiry concerning this communication or earlier communications from the examiner
should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner
can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).
       If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please

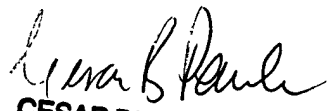allow at least one business day.

Information regarding the status of an application may be obtained from the Patent

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217-9197 (toll-free).

Any response to this Action should be mailed to:
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9/13/06